

THE JOINT EXAMINATION BOARD

PAPER T6

ADVANCED COMMUNITY TRADE MARK AND INTERNATIONAL  
TRADE MARK LAW AND PRACTICE PAPER

23RD NOVEMBER, 2001

10.00 a.m. – 1.00 p.m.

Please read the following instructions carefully. This is a **THREE HOUR** Paper.

1. You should attempt **four** questions (25 marks each).
2. Where a question permits of reasons being given for the conclusions reached, such reasons should be given.
3. Start each question (**but not necessarily each part of each question**) on a fresh sheet of paper. In the appropriate boxes at the top of each sheet please enter the designation of the paper (T6), the question number and your Examination number. Write on **one** side of the paper only using **BLACK** ink. You must **NOT** staple pages together. You must **NOT** state your name anywhere in the answers.
4. Unless specifically requested answers are **NOT** required in letter form.
5. **NO** printed matter or other written material may be taken into the examination room.
6. Answers **MUST** be legible. If the examiners cannot read a candidate's answer no marks will be awarded.
7. **NO** writing whatsoever, including numbering of papers, is allowed prior to the commencement of the examination or after it has finished.
8. **At the end of the examination please double check that you have fully complied with instruction 3 and assemble your answer sheets in QUESTION NUMBER ORDER before placing in the envelope provided.**

This paper consists of 16 pages including this page

## T6

1. You act for Bonzo Breweries Limited, a UK company of some twenty five years' standing who manufacture and sell a range of beers. By far their biggest brand is BONZO, a strong lager which they have sold in the UK on a substantial scale since their incorporation, and in Denmark, France and Germany for about ten years. They plan to commence substantial exports to the remaining EC member states shortly. Their medium term plans for the UK and the rest of the EC include opening a chain of public houses, and providing a range of entertainment services within the context of bars and public houses, although no firm plans for this are yet in place.

They are the proprietors of five national trade mark registrations, and at the end of last year they filed a CTM application which has just been published for opposition purposes. Relevant details of these marks are shown below:

Country	Number	Mark	Class	Filing date	Registration Date
UK	1456023	BONZO	32	10 September 1988	4 April 1990
UK	1456024	BONZO	42	10 September 1988	26 June 1990
Denmark	976/1988	BONZO	32/42	12 September 1988	30 November 1989
France	1452363	BONZO	32/42	14 September 1988	7 June 1989
Germany	3011062	BONZO	32/42	15 September 1988	15 December 1989
CTM*	1704111	BONZO	32/41/42	15 November 2000	-

[ \* Published in OHIM's Official Bulletin for opposition purposes on 10 November 2001]

The above application and registrations cover the following goods and services as appropriate:

- Class 32 "Beers, ales, lagers, alcohol-free beers."  
 Class 41 "Provision and staging of darts, snooker, karaoke and quiz competitions."  
 Class 42 "Public house services, restaurant services".

Your clients recently became aware of a CTM application in the name of Bonzorelli Roma SpA of Italy which was published for opposition purposes on 31 August 2001. Its relevant details are as follows:

Country	Number	Mark	Filing Date	Specification of goods and services
CTM	1811476	BONZO'S	14 January 2001	Provision of live entertainment shows including music, dancing and cabaret. [class 41] Bar services, restaurant services, night club services [class 42]

Commercial investigations into Bonzorelli Roma Spa have revealed that this company has operated a small chain of rather seedy night clubs in Italy since 1996 under the Mark BONZO'S. Your investigations have established that the Italian company has made no other use of BONZO'S in the E.C., and that their only trade mark registration has the following details:

Country	Number	Mark	Filing date	Registration date
Italy	715842	BONZO'S	2 March 1992	15 July 1996
<b>Specification of goods and services</b>				
Provision of live entertainment shows including music, dancing and cabaret. [class 41]				
Bar services, restaurant services, night club services. [class 42]				

Your clients are concerned by the activities of Bonzorelli Roma SpA. Whilst they are prepared to live with this company's use of BONZO'S to date in Italy, their fear is that this will be expanded across the EC into countries where your clients have a substantial reputation. They do not want confusion to arise in the marketplace as the image of BONZO'S night clubs in Italy is incompatible with their own brand identity and could, as they see it, be damaging to their business and reputation.

Make **notes** for a meeting with your clients on the grounds on which Bonzorelli's CTM application could be opposed, your assessment of the likely success of any opposition, the strength of each party's trade mark position and any other issues you think need to be discussed.

**[Note: you need not address any issues relating to well-known marks under the Paris Convention.]**

(25 marks)

- 2(a) You have just acquired a new client, Fit Living Ltd, a small UK company which has for about seven years operated three health clubs under the trade mark SOLOMON in the Manchester area. Each club, in addition to a gym facility, has swimming and sauna facilities and several squash courts. They plan to open retail outlets in their clubs selling sports clothing and equipment but this is a vague strategic plan rather than an imminent development. They are the proprietors of the following UK registration, applied for shortly after they started trading:

Number	Mark	Classes	Filing date	Registration date
2001467	SOLOMON	25, 28, 41 and 42	2 December 1994	26 September 1995
<b>Specification of goods and services</b>				
Class 25: Sportswear and sports shoes.				
Class 28: Sporting apparatus and equipment.				
Class 41: Leisure services; provision of health club, gymnasium and sports facilities; information and advisory services relating to the aforesaid services, and to health and fitness.				
Class 42: Advisory and consultancy services relating to health; physiotherapy services; massage services.				

On 5 November 2001, your clients' previous trade mark attorneys filed a CTM opposition on their behalf against a German company called Werner & Weber GmbH who are seeking to register the Mark SOLON. Copies of the relevant parts of the publication extract for Werner & Weber GmbH's application and the Notice of Opposition as filed (4 pages) are attached.

**Advise your clients on any pre-adversarial formalities, including any likely deadlines, which will need to be addressed prior to OHIM issuing their official letter setting the cooling-off period.**

- (b) Assume that the opposition is now underway. Mid-way through the period set for your clients to complete their opposition and submit any facts, evidence and arguments, the applicants make a request under Article 43(2) that your clients demonstrate that their UK registration has been put to genuine use in the UK. Your clients provide you with a single invoice, a copy of which is attached. They further comment that they may be able to dig out more examples of similar invoices post-dating the attached, that also refer to "health and fitness facilities".

**Advise your clients on what OHIM require for an opponent to successfully deal with an Article 43(2) challenge, and comment on the extent to which the invoice supplied will assist.**

(25 marks)

## Extract from OHIM Official Bulletin Volume 58/01

File number given to the application	001494828
Filing date of application	01/02/01
Date of publication of the application	05/08/01
Reproduction of the Trade Mark in Standard script	SOLOON
Name and address of the applicant	WERNER & WEBER GmbH Elmstr. 62 42111 München DE
Name and address of the representative	TM Attorney & Partner Jungenstr. 33 61480 München DE
Language in which application is filed and second language	DE FR
Goods and services (Nice classification)	ES – 28 DA – 28 DE – 28 EL – 28 EN – 28 – Diving masks, flippers and snorkels FR – 28 IT – 28 NL – 28 PT – 28 FI – 28 SV – 28

# Notice of Opposition

<i>This area is reserved for OHIM</i>	<b>For OHIM</b>	Date of receipt	Number of pages	Opponent's /Representative's reference number
---------------------------------------	-----------------	-----------------	-----------------	---

<sup>1</sup> *Check one of these boxes*

**Language**  
Language of opposition

ES     DE     UK     FR     IT

<sup>2</sup> *Mandatory*

**Opposed application**  
Application number: 1494828

<sup>3</sup> *Mandatory*

Applicant: <sup>3</sup> Werner & Weber GmbH

<sup>4</sup> *Optional*

Date of publication: <sup>4</sup> 5 August 2001

<sup>5</sup> *Indicate ID number if available; if not, complete page 2*

**Opponent**  
ID number of opponent:  given

<sup>6</sup> *Mandatory*

Name of opponent: <sup>6</sup> 6

<sup>7</sup> *Mandatory; check the appropriate box*

**Entitlement**  
Evidence of entitlement: <sup>7</sup>  proprietor     authorised licensee     person authorised under national law

<sup>8</sup>  attached     to follow

<sup>9</sup> *Check the box if a professional representative is appointed*

**Professional representative**  
Professional representative: <sup>9</sup>  appointed

<sup>10</sup> *Indicate ID number if available; if not, complete page 3*

ID number of professional representative: <sup>10</sup>  given    16044

<sup>11</sup> *Mandatory*

Name: <sup>11</sup> 9

<sup>12</sup> *Check this box if OHIM is already in possession of authorisation and*

**Authorisation**  
Authorisation on file: <sup>12</sup>  already on file

<sup>13</sup> *Indicate ID number of authorisation if available*

ID number of authorisation: <sup>13</sup>  given

<sup>14</sup> *Check one of these boxes if authorisation is not on file*

Authorisation not on file: <sup>14</sup>  attached     to follow

<sup>15</sup> *For fees see current table of fees*

**Fees**  
Opposition fee: <sup>15</sup> 350 ECU

<sup>16</sup> *Payment will automatically be deducted from current account unless one of the following boxes is checked or a specific instruction to the contrary is provided*

**Payment**  
Current account: <sup>16</sup>  current account No. 001462

<sup>17</sup> *If payment is remitted indicate OHIM account number*

Remittance to account of OHIM: <sup>17</sup>  OHIM account No.

<sup>18</sup> *and indicate date of remittance of payment*

Date of remittance: <sup>18</sup>

Cheque: <sup>19</sup>  attached

<sup>20</sup> *Optional*

**Signature**  
Date of signing: <sup>20</sup> 5 November 2001

<sup>21</sup> *Mandatory*

Signature: <sup>21</sup>

<sup>22</sup> *Indicate name of person signing*

Name: <sup>22</sup> UK Trade Mark Attorney

<sup>23</sup> *Check as appropriate if signature is by employee representative or professional representative*

<sup>23</sup>  employee     legal practitioner     professional representative

<sup>24</sup> *Total number of sheets, including attachments*

**Number of sheets**  
Number of sheets: <sup>24</sup>

# Notice of Opposition

## Basis of opposition

<sup>53</sup> Check the appropriate boxes and provide the required information hereafter; if opposition is based on more than one earlier mark or sign, additional sheets (copies of this page and page 5) must be completed, (if necessary, for each earlier mark or sign)

Opposition is based on

- <sup>53</sup>  earlier mark (registration or application)
- <sup>54</sup>  earlier registered mark with reputation
- <sup>55</sup>  earlier well-known mark
- <sup>56</sup>  earlier non-registered mark
- <sup>57</sup>  earlier other sign used in the course of trade
- <sup>58</sup>  mark filed by an agent

## Earlier mark (registration or application)

<sup>59</sup> Check one of these boxes.

Type of mark

- <sup>59</sup>  Community mark
- national mark
- international registration with effect in a Member State

<sup>60</sup> If national mark or international registration, check the appropriate box

Member State/s

- <sup>60</sup>  DK  DE  GR  ES  FR  IE  IT  AT  PT  FI  SE   BENELUX

<sup>61</sup> Indicate word mark; if other type of mark, provide a representation on attachment

Representation of the mark

<sup>61</sup> SOLOMON

<sup>62-65</sup> Complete as appropriate; if priority is invoked, provide details on attachment

Filing date

<sup>62</sup> 2 December 1994

Filing No.

<sup>63</sup> 2001467

Registration date

<sup>64</sup> 26 September 1995

Registration No.

<sup>65</sup> 2001467

<sup>66</sup> Copy required only when earlier mark is a national mark or international registration

Copy of registration/application

- <sup>66</sup>  attached
- to follow

<sup>67-68</sup> Check and complete as appropriate; indicate goods/services on which opposition is based; if the space provided is not sufficient, use attachment instead

Opposition is based on

- <sup>67</sup>  all the goods/services for which earlier mark is registered/applied for
- <sup>68</sup>  less than all the goods/services, namely:  
Sporting apparatus and equipment

## Earlier registered mark with reputation

<sup>69</sup> If opposition is based on earlier registered mark with reputation, complete lines 69-70 and box 70 and check as appropriate one of the following boxes

Reputation

- <sup>69</sup>  in the Community
- in a Member State (including Benelux)

<sup>70</sup> Check the appropriate box

Member State

- <sup>70</sup>  DK  DE  GR  ES  FR  IE  IT  AT  PT  FI  SE  GB  BENELUX

<sup>71-72</sup> Check one of the boxes and complete as appropriate; indicate only goods/services for which reputation is claimed; if the space provided is not sufficient, use attachment instead

Opposition is based on

- <sup>71</sup>  all the goods/services for which earlier mark is registered
- <sup>72</sup>  less than all the goods/services, namely:

Evidence of reputation

- <sup>73</sup>  attached
- to follow

# Notice of Opposition

**Earlier well-known mark**

<sup>74</sup> Indicate word mark; if other type of mark, provide representation on attachment  
Representation of the mark 74

<sup>75</sup> Indicate Member State/s where mark is well-known  
Member State/s 75

BE DK DE GR ES FR IE IT LU NL AT PT FI SE GB

<sup>76</sup> If the space provided is not sufficient, use attachment instead  
Opposition is based on the following goods/services 76

Evidence of mark being well-known 77  attached  to follow

**Earlier non-registered mark**

<sup>78</sup> Indicate word mark; if other type of mark, provide representation on attachment  
Representation of the mark 78

<sup>79</sup> Indicate Member State where earlier non-registered mark is protected  
Member State 79

BE DK DE GR ES FR IE IT LU NL AT PT FI SE

<sup>80</sup> If the space provided is not sufficient, use attachment instead  
Opposition is based on the following goods/services 80

To be confirmed

Evidence of protection 81  attached  to follow

**Earlier sign used in the course of trade**

<sup>82</sup> Indicate sign; if the sign is not consisting of a word, provide representation on attachment  
Representation of the sign 82

<sup>83</sup> Indicate nature of rights claimed  
Nature of rights 83

<sup>84</sup> Indicate Member State where earlier sign is protected  
Member State 84

BE DK DE GR ES FR IE IT LU NL AT PT FI SE GB

<sup>85</sup> Indicate goods/services, subject of economic activity; if the space provided is not sufficient, use attachment instead  
Opposition is based on the following goods/services 85

Evidence of protection 86  attached  to follow

**Mark filed by agent**

<sup>87</sup> Indicate word mark; if other type of mark, provide representation on attachment  
Representation of the mark 87

<sup>88</sup> Indicate country/ies where opponent is proprietor of mark  
Country/ies 88

Evidence of ownership of mark 89  attached  to follow



**FIT LIVING LIMITED**

40-50 Burton Street  
Manchester  
M22 1HK

ABC Ltd  
14 Elsworthy Street  
Manchester  
M6 2HN

*INVOICE NO. 0052*

4 January 1996

To: Renewal of annual corporation membership fees for  
1996 in respect of health and fitness facilities for  
5 members – Burton Street club (our ref.SOL 2)

£2750.00

VAT@17.5%

£481.25

**TOTAL**

**£3231.25**

3. Your client, a US corporation ABC, Inc., is the proprietor of various trade mark registrations for BLUE SHOE in respect of "printed matter all relating to music" in Class 16. ABC, Inc. is the proprietor of national registrations for this mark, bearing the filing dates shown below, in the following countries:

Finland	31 October 1991
Germany	6 July 1990
Spain	12 May 1994
UK	27 April 1989

To obtain coverage for the rest of the EU and consolidate their existing protection, your client filed a CTM application on 11 November 2000 for the same Class 16 goods.

You have just received the results from OHIM of the national searches carried out for your client's mark. The Benelux, Finnish and Swedish results have identified International Registration No. 654311 BLUE SHOE in Class 16 in the name of a German company XYZ GmbH.

You have established that the International Registration was filed under the Madrid Protocol. It is based on a German registration filed on 22 February 1991 and bears a date of registration under the Madrid Protocol of 15 December 1996. The specification reads "paper articles; printed matter". In addition to Benelux, Finland and Sweden, the International Registration also designated France at the time of filing, and in August 2001 the proprietor requested additional designations to cover the UK, Japan and Australia. The Finnish, French and Benelux designations have been granted protection, and the Swedish designation was advertised on 23 October 2001.

Advise your client in **note form** on the action they might take regarding use and registration of their mark in the European Union.

(25 marks)

4. A firm of Canadian attorneys have written to you on behalf of their client whose headquarters are in Toronto and which has a wholly owned subsidiary company based in Brussels. They have come up with a new trade mark for which a Canadian national application was filed on 31st May 2001. You receive the attorney's letter on 14th November 2001 saying that their client wants to extend their protection to cover the EU, Bulgaria and Egypt.

The Canadian company recently became aware of the activities of one of its competitors who started selling similar products in the territories of interest under a similar mark in June 2001. As a result of a search, they have discovered that the competitor in question has not applied to register its mark but that there is a potential conflict in France with another third party which is the proprietor of a similar mark for similar goods registered on 14th December 2000.

Your client is keen to obtain quick protection.

Compare and contrast the different filing strategies available to the client in these circumstances.

(25 marks)

5. On 1st November 2001, you receive a fax from the in-house legal counsel of Fine Apparel International, Inc., a California corporation active in importing, exporting and distributing leather clothing throughout Europe and North America, which reads as follows: -

"As you may know, we have been marketing a range of leather clothing under the brand name COSTA BRAVA in the United Kingdom, France, Germany, Austria, Spain and Italy for about four years.

The range is produced in Spain and enjoys strong sales there, and modest to strong sales elsewhere. This brand is important to us as it is the only product we currently sell in the low-to-medium price bracket in Europe.

Recently, we noted that a German company, Mantel GmbH, had applied to register COSTA BRAVA as a Community trade mark in respect of "clothing" in Class 25. Following a direct approach we made, Mantel advised that it was not using the mark and agreed to assign it to us. The assignment has now been executed and the German lawyers acting for Mantel have, after some delay, finally provided us with their prosecution file, a copy of which we are faxing herewith.

We would like you to take over prosecution of this application. Please take whatever action is necessary to preserve our position and advise us on how we should proceed."

Reviewing the papers, you note that the application was filed on 10th March 2001 in German, with French as the second language. An examination report was issued on 27th September. There is an objection that the mark is devoid of any distinctive character and is descriptive of leisure clothing from the environs of the Costa Brava, a holiday region which is well known in Spain. There is a deadline of 27th November for response. No response has yet been filed.

Make notes on the following:

1. The steps you would take to prosecute the application, including any information and materials you will need from your client.
2. Briefly, the options open to your client if the application is rejected, and any time limits.

(25 marks)

6. The partner for whom you work has just come into your office and handed you a file of papers.

"I've just had a phone call from the Chief Executive Officer of TDO cosmetics Limited, that new client we saw last month. One of the files they transferred to us was for the MOONLIGHT CTM – the details are in the file. The CEO has now decided he wants to go over this as a matter of urgency. He thinks he's got an infringement problem on his hands – a company called Biometrics is using SERIOUS MOONLIGHT. It's all in the attached papers – but he's coming in in an hour to discuss it, with a view to some sort of action, even if it's only a nasty letter. What I need you to do is to provide me with practical notes for my meeting – whether there is a strong case for infringement, options for jurisdiction, in general terms what we can get by way of court orders, and any other problems we need to consider given the information we have, together with any other recommendations for action."

The relevant details of your clients' CTM registration are as follows:

Number	Mark	Class	Filing date	Specification
1234567	MOONLIGHT	3	2 January 2001	Skin care preparations

The contents of the file are:

- Partner's telephone attendance note
- Investigator's report
- Details of one mark revealed through an on-line search

Based on the information given prepare notes for the meeting.

(25 marks)

## TELEPHONE ATTENDANCE NOTE

**10.30 a.m.** 15/11/2001

**Caller:** Jim Jones, CEO TDO Cosmetics Inc

**Subject:** Use of SERIOUS MOONLIGHT by Biometrics Limited

---

TDO own CTM Reg No. 1234567 MOONLIGHT in Class 3, dated 2 January 2001. TDO did the registration work themselves. Went through without opposition.

MOONLIGHT hasn't been used but is one of a batch of "shelf" marks intended for a face-and body moisturising lotion. A final decision hasn't been taken yet on the brand but this is the favourite at the moment. Planned launch in about 6 months. UK, FR, DK, ES, DE.

Biometrics is main competitor in Europe. Jim has heard that Biometrics are apparently selling an organic face cream under the name SERIOUS MOONLIGHT; Jim's had an investigator look into this and apparently they are currently selling in the UK, FR and DE.

Jim is keen to stop Biometrics – he feels the product and mark are too close to his company's interest and could adversely affect his launch/marketing plans. They've put a lot of money into the proposed launch. On the other hand, Jim doesn't want to waste time and money if he's not going to win. Feels that we should at least write a warning letter – doesn't see the point in having a CTM otherwise.

## LEVINGTON INVESTIGATORS

### Target: Biometrics Limited, trade mark "SERIOUS MOONLIGHT" Report of Angus Hampson

Pursuant to instructions received I telephoned the customer service department of the target on 10 November 2001 at 10.00 hours. I spoke with a lady who identified herself as Agnes Stoddart, marketing Executive. Using an appropriate cover story, I asked about placing an order for SERIOUS MOONLIGHT face cream.

She told me "I can't get you supplies right now, but we should have some free in a month or so. SERIOUS MOONLIGHT is really just for the EU market right now, it goes particularly well in France – we tried to move it here but there are too many established brands in the marketplace. We did some small-scale test marketing in Boots and Superdrug, and some smaller outlets, just in Liverpool and Bristol in October 2000, but it just didn't catch on. We will try again at some point, and we have carried on selling small quantities to order in those areas – we've had a few sales elsewhere, too, but nothing substantial – small but steady really, and we're keen to try to improve its position here if we can. We rolled it out in France in February 2001 and it really took off in the Summer. It is now selling very well in France and Germany, with distributors about to be appointed for some of the other countries".

We then finished our conversation, Mrs Stoddart will be sending me a brochure.

I rang Boots' and Superdrug's national customer service lines. Boots had "a few bottles" of SERIOUS MOONLIGHT in stock in Liverpool, but Superdrug said they last had it in three months ago in Bristol and didn't know if they would be getting any more.

---

An online search reveals the following mark:

Number	Mark	Class	Status	Filing Date	Proprietor	Specification
1354689 (CTM)	SERIOUS MOONLIGHT	3	Pending – Opposed	1 February 2001	Biometrics Limited	Products for care of the skin

Searches were then made at Companies House into the Company Biometrics Limited, Co. Number 89898989; the Company was incorporated on 3 March 1989 and has a registered office at 139 East Side Walk, London EC1.